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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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3609

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,984

Applicant(s)

AIDA ET AL.

Examiner

Christopher C. Johns

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/12/04, 12/21/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 rejected under 35 U.S.C. 103(a) as being unpatentable over US Pre-Grant Publication 2001/0034846 (hereafter referred to as Beery).

As per claims 1-6:

Beery provides a method for allowing authenticated users to use computer software packages. The application allows for installation from removable media (such as a compact disc, as in Figure 5c) or from the Internet (cf. Figure 5b), onto users' personal computers or other devices (cf. page 1, first column, paragraph 6) (*1: "a server operable to provide software via a network to a plurality of electronic devices; at least two electronic devices..."*).

Beery provides for a user's terminal to initiate login procedures (cf. Figure 5b, reference number 214), send device identification information (cf. Figure 5b, reference numbers 232, 233, 236), and send a request for software (cf. page 5, first column, paragraph 46 – "User with computing device...submits personal information along with a request for data or software"). It further discloses the ability to install said software package (cf. Figure 5b, reference number 252) (*1: "first requesting means for sending the user identification information and the device identification information for the electronic device, and software identification information for selected software, to the server to request that the selected software be provided; installing means for installing the selected software provided from the server"*). As disclosed in the specification, the users are associated with the computers (cf. page 5, second column, paragraph 46 – "Registration database server 210 queries database to find pre-existing user and machine data registrations. Matching previous registrations are compared against present user and computing device information; if authenticated by authentication server 208 the installation continues...") (*1: "each of the at least two electronic devices being identified by device identification information registered in association with user identification information identifying a single user of the at least two electronic devices..."*).

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Beery also provides the server counterpart to the above-described user device. Beery provides for accepting information concerning which software package is requested (cf. page 5, first column, paragraph 46 – “User with computing device...submits personal information along with a request for data or software”), as well as accepting the user and device identification (cf. reference numbers 218 and 236), where the user and device information have been associated with each other (cf. page 5, second column, paragraph 46 – “Registration database server 210 queries database to find pre-existing user and machine data registrations. Matching previous registrations are compared against present user and computing device information; if authenticated by authentication server 208 the installation continues”) (1: *“the server including: registering means for registering the software identification information for the selected software in association with the user identification information and the device identification information for the electronic device on condition that the user identification information and the device identification information for the electronic device have been registered in association with each other”*). It further can provide the software to the requesting user’s computer, where it will be received (cf. reference number 250) (1: *“providing means for providing the selected software to the electronic device”*, 6: *“receiving means for receiving the selected software from the server”*).

The computer described in Beery is not disclosed to have “running means” for the software. However, it was inherently obvious to one skilled in the art at the time of the invention to have the ability to run the software that one has acquired (1: *“running means for running the selected software using the license”*).

Beery does not explicitly detail the transference of licenses for said software packages, from said servers to said electronic devices. However, the invention is drawn to “distributing licensed software across a network” (cf. page 1, first column, paragraph 6) so by distributing the software, an inherent license is distributed at the same time (1: *“second requesting means for sending the software identification information for the selected software, the user identification information, and the device identification information for the electronic device to the server to request that a license required to run the selected software be generated based on predetermined license generating information and be provided to the electronic device...generating means for generating the license when the software identification information for the selected software, the user identification information, and the device identification information for the electronic device have been registered in association with each other”*).

Neither the user’s terminal nor the serving computer in Beery disclose the ability to request a transfer of license or the ability to automatically transfer a license. However, agreements called “End User License Agreements” are well known to those skilled in software licensing. Defined as “A legal agreement between a software manufacturer and the software’s purchaser with regard to terms of distribution, resale, and restricted use” (cf. Microsoft Computer Dictionary, 5th edition), these licenses

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frequently include clauses relating to transfer of licenses between users. The included example, a manual from Microsoft MS-DOS and Windows, contains one of such End-User License Agreements. Clause 5, "Other Restrictions", states that a user may "transfer [the] rights under this Microsoft License Agreement on a permanent basis, provided [that the user] transfer all copies of the software and all written materials, and the recipient agrees to the terms of this Agreement".

While, as stated, Beery does not explicitly teach automatic transfer of licenses, it would be obvious to one skilled in the art at the time of the invention to implement a system to transfer said licenses between users. Merely providing an automatic means (the system described in the instant application) to replace a manual activity (in this case, transfer of software and licensing), where the automatic means accomplishes the same result, is not sufficient to distinguish over the prior art; cf. *In re Venner*, 120 USPQ 192, 194; 262 F.2d 91 (CCPA 1958). A simple automation of the process of transferring "all copies of the software" as well as the license has the same result as manually performing said process. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to automate the license transfer because the process would be accomplished more quickly but the result is exactly the same (1: *"third requesting means for requesting that the server transfer the selected software to another of the at least two electronic devices...transferring means for, upon a request by the third requesting means of the electronic device to transfer the selected software to the another electronic device, deleting the software identification information for the selected software and the user identification information and the device identification information registered in association with the software identification information, and registering the software identification information for the selected software in association with the device identification information for the another electronic device and the user identification information"*)

Claims 2-5 are essentially identical to claim 1. Claim 2 is an apparatus, claim 3 is a method, claim 4 is recordable media with a computer readable program, and claims 5 and 6 are drawn to systems for providing software. All are similarly rejected.

As per claim 7:

Claim 7 is rejected under the same reasoning as claim 1 above, except for the "storage means" which keeps the device identification and user identification. Beery covers this (cf. page 5, first and second columns, paragraph 46 – "Authentication web site sends user information to registration database. Registration database searches for previous user information instances by comparing any existing information with the information submitted in the present instance... Registration database server queries database to find pre-existing user and machine data registrations. Matching previous registrations are compared against present user and computing device information; if authenticated by authentication server, the installation continues...") (7: *"storage means for storing device identification information for an electronic device and user"*)

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identification information identifying a user of the electronic device in association with each other").

Claim 13 is a method claim that mirrors the limitations of claim 7, and is similarly rejected.

As per claim 8:

Furthermore, this information inherently must be stored in the database for it to be accessible through the database (8: "when the receiving means has received the software identification information for the selected software, the storage means stores the software identification information for the selected software in association with the device identification information for the electronic device").

Claim 14 is a method claim that mirrors the limitations of claim 8, and is similarly rejected.

As per claim 9:

Also inherent are the actions taken when the license is transferred; to keep the database up-to-date, the old data must be replaced with the new data (9: "*when the changing request has been received from the electronic device, the device identification information for the electronic device stored in the storage means is replaced with the device identification information for the another electronic device*").

Claim 15 is a method claim that mirrors the limitations of claim 9, and is similarly rejected.

As per claims 10-12:

Authentication takes place in order to guarantee that the user identification and device authentication are valid. It is done, as stated in claim 1, before software is sent, to guarantee that the software will not be installed on unauthorized machines (cf. Figure 5b, reference number 220) (10: "*the receiving means receives the user identification information identifying the user of the electronic device and the device identification information for the electronic device together with the software identification information for the selected software, and the software sending means carries out authentication based on the user identification information and the device identification information for the electronic device before sending the selected software to the electronic device*").

Finally, it would be obvious to one skilled in the art at the time of the invention to automatically transfer the software when the license is transferred. Merely providing an automatic means (the system described in the instant application) to replace a manual activity (in this case, transfer of software), where the automatic means accomplishes the

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same result, is not sufficient to distinguish over the prior art; cf. *In re Venner*, 120 USPQ 192, 194; 262 F.2d 91 (CCPA 1958). A simple automation of the process of transferring "all copies of the software" has the same result as manually performing said process. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to automate the software transfer because the process would be accomplished more quickly but the result is exactly the same (**11**: *"the changing means receives the user identification information identifying the user of the electronic device and the device identification information for the electronic device together with the changing request, and carries out authentication based on the user identification information and the device identification information for the electronic device before executing the changing operation"*, **12**: *"the software providing means sends the selected software to the another electronic device when the changing operation has been executed"*).

Claims 16-18 are method claims that mirror the limitations in apparatus claims 10-12, and are similarly rejected.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent 6,954, 753, covering a "Transparent electronic safety deposit box", where security in the system is based on both a user ID and an identification of the system processor (CPU).
- US Patent 6,233,567, covering a "Method and apparatus for software licensing electronically distributed programs", whereby both "Machine Unique Identifier" and "User Payment Information" are used to create a registration key.
- US Patent 5,825, 893, covering a "System and method for registration using indicia", where registration of a product can involve "user information", "a serial number of [the] product", and "a serial number of a portable device"

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- US Patent 5,199,066, covering a "Method and apparatus for protecting software", whereby a method for protecting software uses a "hardware code" and the serial number of the software in question.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is 571-270-3462. The examiner can normally be reached on Monday-Thursday, 7:30-5, Alternate Fridays, 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher Johns
Examiner
Art Unit 3609

CCJ


THOMAS A. DIXON
SUPERVISORY PATENT EXAMINER